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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,076	10/07/2003	Daniel Resnic		7675

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ERIC HANSCOM
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EXAMINER	
OSTRUP, CLINTON T	
ART UNIT	**PAPER NUMBER**
3771	
NOTIFICATION DATE	**DELIVERY MODE**
03/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eric@erichanscom.com
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Office Action Summary	Application No.	Applicant(s)	
	10/681,076	RESNIC, DANIEL	
	Examiner	Art Unit	
	CLINTON OSTRUP	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 May 2008*.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-38* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *27-38* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *07 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Supplemental Amendment filed 5/29/08. As directed by the amendment, claims 1-26 have been cancelled and claims 27-38 have been added. Thus, claims 27-38 are pending in this application.

Drawings

2. The drawings are objected to because reference character “17” in figure 8 should be characterized as reference character “18”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows (4,798,600).

Regarding claims 27 & 29, Meadows discloses a condom comprising tubular body (12) with a closed distal end and an open proximal end (figure1), where the tubular body defines a cavity (inside 12), where the cavity is capable of accepting a penis (figure 2), where the tubular body has a thickness greater than the thickness greater than normally employed in conventional condoms (col. 4, lines 34-50), where the walls of the condom are made from a material that is elastic (latex rubber), and a ring or collar (22), where the ring or collar is directly connected to the tubular body at the open proximal end (figures 1-4).

Although Meadows discloses a tubular member with a thickness of at least 0.025 centimeters and suggests using a thickness of material much greater than normally employed, Meadows lacks the specific thicknesses as claimed in claims 27 and 29.

It is the examiners position that a thickness of greater than 0.025 centimeters encompasses those claimed; however, even if applicant disagrees, it has been well established that the optimization of proportions in a prior art device is a design consideration within the skill of the art, particularly given the teachings of Meadow.

Regarding claim 28, silicone rubber is a commonly known material and it has been held that the selection of a known material based on its suitability for the intended use is a design consideration within the skill in the art. In re Leshin, 227 F. 2d 197, 125 USPQ 416 (CCPA 1960).

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows (4,798,600), as applied to claim 1 above, and further in view of Lash (4,867,176).

Meadows discloses all the limitations of claims 30, except the diameter of the tubular body, when traveling from the proximal end to the distal end, first decreases, then increases, and then decreases thereby providing a tapered section near the proximal end, whereby a passive sexual partner can retain the condom within his or her orifice by means of muscle contraction about the tapered section.

Lash teaches a tubular body with a diameter of the tubular body, when traveling from the proximal end to the distal end, first decreases, then increases, and then decreases thereby providing a tapered section near the proximal end, whereby a passive sexual partner can retain the condom within his or her orifice by means of muscle contraction about the tapered section. See: col. 2, lines 43-49 and figures 5 & 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the shape of the tubular device disclosed by Meadows to have a shape that aids in retention of the condom after insertion, as taught by Lash, in order to provide a condom with a shape that maintains the condom in the vagina during intercourse.

6. Claims 31 & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows (4,798,600) in view of Hogin (4,354,494).

Regarding claim 31, Meadows discloses a condom comprising tubular body (12) with a closed distal end and an open proximal end (figure1), where the tubular body defines a cavity (inside 12), where the cavity is capable of accepting a penis (figure 2), where the tubular body has a thickness greater than the thickness greater than normally employed in conventional condoms (col. 4, lines 34-50), where the walls of the condom are made from a material that is elastic (latex rubber), and a ring or collar (22), where the ring or collar is directly connected to the tubular body at the open proximal end (figures 1-4).

Although Meadows discloses a tubular member with a thickness of at least 0.025 centimeters and suggests using a thickness of material much greater than normally employed, Meadows lacks the specific thicknesses as claimed in claim 31 and the scrotum strap, where the scrotum strap comprises two ends, where at least each of the two ends is directly connected to the ring or collar, where the scrotum strap is capable of being stretched around the scrotum of a male user as claimed in claim 32.

It is the examiners position that a thickness of greater than 0.025 centimeters encompasses those claimed; however, even if applicant disagrees, it has been well established that the optimization of proportions in a prior art device is a design consideration within the skill of the art, particularly given the teachings of Meadow.

Hogin teaches a tubular member (10) with a scrotum strap (20), where the scrotum strap comprises two ends (24 & 26), where at least each of the two ends is directly connected to the ring or collar (18) , where the scrotum strap is capable of being stretched around the scrotum of a male user (figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the ring member on the tubular member disclosed by Meadows by integrating a scrotum strap, as taught by Hogin, in order to provide a user with a condom that would not slip off during intercourse.

Regarding claim 32, silicone rubber is a commonly known material and it has been held that the selection of a known material based on its suitability for the intended use is a design consideration within the skill in the art. In re Leshin, 227 F. 2d 197, 125 USPQ 416 (CCPA 1960).

7. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows (4,798,600) in view of Park et al., (4,972,849).

Regarding claim 33, Meadows discloses a condom comprising tubular body (12) with a closed distal end and an open proximal end (figure1), where the tubular body defines a cavity (inside 12), where the cavity is capable of accepting a penis (figure 2), where the tubular body has a thickness greater than the thickness greater than normally employed in conventional condoms (col. 4, lines 34-50); however, Meadows lacks the an inner wall, where the inner wall and tubular body define a reservoir, where the reservoir is located at the distal end of the condom, where the inner wall is a circumferential piece of the condom with an opening in the middle, where the inner wall is funneled toward the distal end of the condom whereby, when semen is ejaculated into the reservoir, the funneled direction of the inner wall serves to trap at least a portion of the semen within the reservoir.

Park teaches a tubular member condom having an inner wall (figure 7) where the inner wall and tubular body define a reservoir (6), where the reservoir is located at the distal end of the condom (tip), where the inner wall is a circumferential piece (7) of the condom with an opening in the middle, where the inner wall is funneled (it is tapered) toward the distal end of the condom whereby, when semen is ejaculated into the reservoir, the funneled direction of the inner wall serves to trap at least a portion of the semen within the reservoir.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the distal end of the tubular condom disclosed by Meadows by using a the reservoir, as taught by Park, in or the to obtain a condom that discourages premature ejaculation while simultaneously keeps the bodily fluids away from the shaft of the penis.

Regarding claim 34, silicone rubber is a commonly known material and it has been held that the selection of a known material based on its suitability for the intended use is a design consideration within the skill in the art. In re Leshin, 227 F. 2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 35, Park teaches a sponge (col. 3, lines 46-53) capable of absorbing fluids, whereby said sponge (2) is capable of absorbing bodily fluids propelled into the reservoir (6) thereby further trapping at least a portion of the semen within the reservoir. See: figure 7.

8. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows (4,798,600) in view of Hogin (4,354,494), as applied to claim 31 above, and further in view of Park et al., (4,972,849).

Regarding claim 36, Meadows discloses a condom comprising tubular body (12) with a closed distal end and an open proximal end (figure1), where the tubular body defines a cavity (inside 12), where the cavity is capable of accepting a penis (figure 2), where the tubular body has a thickness greater than the thickness greater than normally employed in conventional condoms (col. 4, lines 34-50), where the walls of the condom are made from a material that is elastic (latex rubber), and a ring or collar (22), where the ring or collar is directly connected to the tubular body at the open proximal end (figures 1-4).

Although Meadows discloses a tubular member with a thickness of at least 0.025 centimeters and suggests using a thickness of material much greater than normally employed, Meadows lacks the specific thicknesses as claimed in claim 31 and the scrotum strap, where the scrotum strap comprises two ends, where at least each of the two ends is directly connected to the ring or collar, where the scrotum strap is capable of being stretched around the scrotum of a male user and the inner wall, where the inner wall and tubular body define a reservoir, where the reservoir is located at the distal end of the condom, where the inner wall is a circumferential piece of the condom with an opening in the middle, where the inner wall is funneled toward the distal end of the condom whereby, when semen is ejaculated into the reservoir, the funneled direction of the inner wall serves to trap at least a portion of the semen within the reservoir.

It is the examiners position that a thickness of greater than 0.025 centimeters encompasses those claimed; however, even if applicant disagrees, it has been well established that the optimization of proportions in a prior art device is a design consideration within the skill of the art, particularly given the teachings of Meadow.

Hogin teaches a tubular member (10) with a scrotum strap (20), where the scrotum strap comprises two ends (24 & 26), where at least each of the two ends is directly connected to the ring or collar (18) , where the scrotum strap is capable of being stretched around the scrotum of a male user (figure 1).

Park teaches a tubular member condom having an inner wall (figure 7) where the inner wall and tubular body define a reservoir (6), where the reservoir is located at the distal end of the condom (tip), where the inner wall is a circumferential piece (7) of the condom with an opening in the middle, where the inner wall is funneled (it is tapered) toward the distal end of the condom whereby, when semen is ejaculated into the reservoir, the funneled direction of the inner wall serves to trap at least a portion of the semen within the reservoir.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the tubular shaped condom disclosed by Meadows by utilizing a scrotum strap, as taught by Hogin, and with a distal end that discourages premature ejaculation while simultaneously keeps the bodily fluids away from the shaft of the penis in order to provide a condom that minimizes slippage by securing the condom to a male user and entrapping ejaculated bodily fluids.

Regarding claim 37, silicone rubber is a commonly known material and it has been held that the selection of a known material based on its suitability for the intended use is a design consideration within the skill in the art. In re Leshin, 227 F. 2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 38, Park teaches a sponge (col. 3, lines 46-53) capable of absorbing fluids, whereby said sponge (2) is capable of absorbing bodily fluids propelled into the reservoir (6) thereby further trapping at least a portion of the semen within the reservoir. See: figure 7.

Response to Arguments

9. Applicant's arguments with respect to claims 27-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Quiroz (4,875,490); Johnson (Des. 417,502; Pohlman (2005/0016546); Jaegle (DE 4225160 A1) and Austin et al (2002/0038658) which both disclose tubular condom devices.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON OSTRUP whose telephone number is (571)272-5559. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Clinton Ostrup/

Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771